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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,557	09/30/2003	Terry L. Schneider	7784-000553CPC	6819
27572	7590	12/01/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			DIXON, MERRICK L	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 12/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,557

Applicant(s)

SCHNEIDER, TERRY L.

Examiner

Merrick Dixon

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date see office action.

- MERRICK DIXON
PRIMARY EXAMINER
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The instant application contains two(2) PTO-1449:

PTO-1449's has dates as follows:

2-9-2004

9-7-2004.

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The abstract of the disclosure is objected to because it contains the legal word, "comprise". Correction is required. See MPEP § 608.01(b).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xie et al(US 6,503,620) in view of Minners(US 6,236,300). The primary reference teaches the basic claimed invention including an adhesive compound and a plurality of fillers/particles therein- col 2, line 41- col 3, line 4; col 4, lines 47-56; col 5, lines 47-57; col 6, lines 3-11; col 7, lines 31-46; col 16, line 55 – col 17, line 7. Although the reference teaches particles in its adhesive material, it fails to expressly teach that such particles are SMA. The secondary reference to Minners, however, teaches that SMA are notoriously known for desired properties and would be readily included in resin polymer material such as taught by the primary reference - col 4, lines 3-11- in an effort to impart desired final product characteristics on same - col 3, lines 29-34. It would have been obvious

to one of ordinary skill in the art at the time the invention is made to combine the teachings of the secondary reference to Minners and include SMA particles in the primary reference's resin material, in the absence of unexpected results and to produce desired product characteristics. See Xie et al, also- col 7, lines 3-10. Concerning claims 2, 15 and 23, the secondary reference teaches the claimed particles in col 3, lines 51-54. Concerning claims 3, 4, 16, 17, 25 and 26, the secondary reference teaches the claimed phrases for the SMA in col 3, lines 14-50; col 1, lines 34-42. Concerning claims 5, 20 and 27, the primary reference teaches shapes in col 7, lines 1-3. Concerning claims 7, 8, 18, 19, 28 and 29, the primary reference teaches similar sma amounts in col 5, lines 47-57. Concerning claims 11-13 and 24, the cited reference teaches similar claimed dimensions in col 6, lines 3-11. Concerning claims 6, 14 and 21, the primary reference teaches similar particle disposition in its resin in col 7, lines 35-40. It is further submitted that the particles would indeed be also and randomly distributed in the resin by virtue of its incorporation therein in and in the absence of unexpected results. Concerning claims 9, 10 and 22, the primary reference teaches adhesive film and paste material in col 8, lines 40-54; col 7, lines 41-46, respectively. The secondary reference accordingly teaches that it is known to attach material with SMA included therein to substrate in, with no adverse affects - col 6, lines 42-46.

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Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096

O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal.**

Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 703-872-9306.

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Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquiries for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern time . The examiner's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a stylized, cursive script.

Merrick Dixon

Primary Examiner

Group 1700